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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,386	01/26/2004	Ronald L. Smith	61224-014	4570

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MCDERMOTT, WILL & EMERY
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Washington, DC 20005-3096

EXAMINER

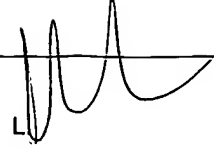
SUHOL, DMITRY

ART UNIT PAPER NUMBER

3714

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/763,386	Applicant(s) SMITH, RONALD L. 	
	Examiner Dmitry Suhol	Art Unit 3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/26/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In analyzing claim 16-17 for patent eligible subject matter, it is useful to first answer the question "What did applicant[s] invent?" In re Abele, 214 USPQ 682 (CCPA 1982). The preamble of claim 16 characterizes the invention as a "method of making a decorative article . . .".

Having determined in general what the invention is, we must analyze it under the prevailing case law. The statute itself allows for the patenting of processes. However, it has been determined in many contexts that not all processes set forth patent eligible subject matter. One test that has recently been applied is whether the invention produces a useful, concrete, tangible result. See e.g., States Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed. Cir. 1998); AT&T Corp. v. Excel Communications Inc., 50 USPQ2d 1447 (Fed. Cir. 1999). Under that test, the invention must have practical utility, it must produce an assured result, and it must not be merely an abstraction lacking in physical substance.

In this case, the claimed invention does not produce a "concrete" result in the sense that it cannot be reasonably assured that a decorative article will be predictably made by the steps set forth. The method only provides for a plurality of pieces that go

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into the manufacture of a decorative article but there are no active method steps which enable the actual manufacture of a decorative article. In other words simply providing the necessary tools and equipment to make a decorative article does not produce a concrete result that an article is actually made. The process itself is no more than an attempt and a hoped-for result.

Claims 16-17 do not produce a concrete result. Accordingly claims 1-17 do not define statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-7, 9-10, 13, 16, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder '309 in view of article entitled "A Hard Look At Ceramic Tile" from Flooring publication, herein referred to as Flooring. Snyder discloses a kit and method for making a decorative article containing most of the elements of the claims including, providing a support having a grid array on one surface thereof as required by claims 1, 10, 14, 16 and 18 (fig. 3), providing a plurality of tiles each tile having an area, a color and corresponding to the grid array as required by claims 1, 10, 14, 16 and 18 (fig. 6 and col. 2, lines 18-27). Each tile comprising fabric as required by claim 4 is described in col. 2, lines 39-44. Tiles differing in color as required by claims 5, 10, 14 (having color as required by claim 16) are described at col. 2, lines 22-23. A source of

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information illustrating how each of the plurality of tiles corresponds to the grid array to form a decorative article, as required by claims 6, 10, 15 and 16, is described at col. 2, lines 5-38 as indicia 15 and 17 and their relationship. A support having a grid array containing a plurality of regularly shaped segments (14) having a symbol or a number therein (15) as required by claims 10 and 14 is shown at figure 3. Attaching each tile to each segment making up a grid array, as required by claim 18, is described at col. 2, lines 5-38 and lines 45-60.

Snyder fails to explicitly teach that the tiles of his kit have an area from about $\frac{1}{8}$ inch squared to about $\frac{1}{2}$ inch squared (1 inch squared as required by claim 14) as required by claims 1, 10, 16 and 18, the area being $\frac{1}{3}$ inch squared to $\frac{1}{2}$ inch squared as required by claims 9 and 13, a support having a length and a width of each from about 6 inches to about 60 inches as required by claim 3, a plurality of tiles comprising an adhesive backing as required by claims 7, 10 and 14 and tiles having a glossy surface as required by claims 10 and 14. However Snyder clearly discloses that his tile elements may be of a variety of sizes (including a small size) depending on desired pattern (col. 2, lines 62+), while Flooring discloses that tiles come in a variety of sizes including one of $\frac{1}{2}$ inch squared (see page 1, 6th paragraph) as well as glossy surfaces (page 1, paragraph 5, where a glazed surface is considered to be glossy). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to have provided the kit of Snyder with tiles having an area of $\frac{1}{2}$ inch squared and a glossy surface for the purpose of having a tile that which is small enough

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as to facilitate formation of patterns with curved or irregular dividing lines and attractive to the user.

Regarding the dimensions of the support as required by claim 3, it would have been obvious to manufacture the support of Snyder in a variety of sizes, including one having a length and width of about 6 inches to 60 inches for the purpose of interest/attractiveness to the consumer, especially since Snyder states that his decorative article is framed for display upon completion (col. 2, lines 56-60) where the examiner takes official notice that decorative articles are notoriously well known to come in a variety of sizes including the size range of 6 to 60 inches in length and width. Furthermore, the dimensions of the support is an obvious design choice in that the applicant discloses no advantage or critical need for such dimensions (XXXXXXXXXX).

Regarding the limitations of claims 7, 10 and 14, Snyder teaches the use of an adhesive surface (11) to attach the mosaic elements (16) to a supporting surface (10). The adhesive surface of Snyder is provided on the support surface, however it would have been obvious to have provided an adhesive surface on the mosaic elements for the purpose of not exposing the entire adhesive surface at one time thereby preventing damage of the surface, especially since such construction is well known in the art (see Terwilliger U.S. Patent No. 4,079,554 at col. 3, lines 7-14 relied upon as extrinsic evidence of known construction) and since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder '309 and Flooring, as stated above, and further in view of Yokomizo '641.

Snyder, as modified by Flooring, discloses all of the elements of the claims, as stated above, but for the support being foam board as required by claims 2 and 12. However, Snyder clearly discloses that the support of his kit made be made of a variety of suitable materials (col. 1, lines 61-62), while Yokomizo discloses a device for manufacturing decorative items which teaches the use of foam board as a support surface for tile like elements which are adhered there on (figure 7 and 11 and col. 1, lines 53-60).

Therefore it would have been obvious to utilize a foam board support surface in the kit of Snyder for the purpose of providing a support surface which is durable with certain amount of rigidity to which a decorative item can be easily attached.

Claims 8, 11, 14-15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder '309 and Flooring, as stated above, and further in view of Morrison '535. Snyder, as modified by Flooring, discloses all of the elements of the claims, as stated above, but for using a blunt tool for handling/attaching at least one of the plurality of tiles as required by claim 8, 11, 14, 17 and 19. However Morrison discloses a method for making a decorative article which teaches that it is known to utilize a blunt instrument (tweezers 15) to handle/attach tile like elements when placing them on a base support surface (see figure 3 and col. 1, lines 35-37). Therefore it would have been obvious to include a blunt device and the step of using it in the kit of Snyder

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for the purpose of handling/attaching his tiles during placement of them on the support surface.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ds

Dmitry Suhol
Dmitry Suhol